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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,294	12/05/2001	Jon A. Wolff	MIRUS.003.06.1	8816
7590 12/10/2004			EXAMINER	
Mark K. Johnson PO Box 510644 New Berlin, WI 53151-0644			DAVIS, BRIAN J	
			ART UNIT	PAPER NUMBER
			1621	
DATE MAILED: 12/10/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/005,294	Applicant(s) WOLFF ET AL.	
	Examiner Brian J. Davis	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/26/04 (*petition*).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 is/are allowed.
- 6) ☒ Claim(s) 6,8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Petition Decision

Due to a favorable petition decision (11/05/04), this application has been revived and prosecution continued.

112 Rejections Withdrawn

The rejection of claims 6-8 under 35 USC 112, second paragraph, outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment clarifies the claim text and diagrams as appropriate.

102 Rejections Maintained

The rejection of claim 6 under 35 USC 102(b), outlined in the previous Office Action, is maintained for reasons of record. Applicant's arguments and amendment have been carefully considered, but are not persuasive.

Firstly, the examiner respectfully points out that during patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F. 3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

Applicant defines orthogonal protecting groups as "...a protective group that can be selectively removed in the presence of other protective groups..." (page 22 line 30). Furthermore, applicant defines a protective group as "...a chemical group that is

temporarily bound to functionalities within a multifunctional compound that allows selective reactions to take place at other sites..." (page 22 line 36).

The cited prior art, using the instant variable labels, has $R = -C(O)(CH_2)_{16}Me$ and $R' = -SO_3$. These groups are encompassed by applicant's definitions and may be considered as orthogonal protecting groups: They are different chemical moieties temporarily bound to a functionality (protective aspect; all chemical bonds can be thought of as temporary) and since they differ in structure and thus in properties, would be expected to behave differently under different reactions conditions (orthogonal aspect).

The rejection of claim 8 under 35 USC 102(b), outlined in the previous Office Action, is maintained for reasons of record. Applicant's arguments and amendment have been carefully considered, but are not persuasive.

The examiner respectfully points out that claim 8 is a compound claim drawn to compounds defined by the general structure in the claim. The addition of limitations into the preamble adds no patentable weight. This is so because a compound and its properties are inseparable. *In re Papesch*, 315, F.2d 381, 137 USPQ 43 (CCPA 1963). See also: 1) *In re Ridden*, 318, F.2d 761, 138 USPQ 112; *In re Maeder*, 337 F.2d 875, 143 USPQ 248; *Ex parte Maxey*, 177 USPQ 468 (POBA 1972); *In re Spada*, 911 F.2d 705, 15 USPQ 2d 1655 (Fed. Cir. 1990). Recitation of the intended utility into the preamble of a compound claim which can otherwise stand alone is not considered a further limitation on the claim; and 2) A "use" can only be properly claimed as a process

or method. 35 USC 100(b), 101. See also *Clinical Products v. Brenner*, 255 F. Supp. 131, 149 USPQ 475, 477 (DDC 1966); *In re Thuau*, 1943 CD 390.

103 Rejections Maintained

The rejection of claim 8 under 35 USC 103(a), outlined in the previous Office Action, is maintained for reasons of record. Applicant's arguments and amendment have been carefully considered, but are not persuasive.

As above, The examiner respectfully points out that claim 8 is a compound claim drawn to compounds defined by the general structure in the claim. The addition of limitations into the preamble adds no patentable weight.

Allowable Subject Matter

Claim 7 is allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

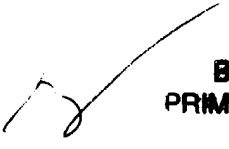
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN DAVIS
PRIMARY EXAMINER
Brian J. Davis
December 1, 2004